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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/868,435	10/01/2001	Daniel Doll-Steinberg	4267-4000	1453
27123	7590	10/31/2005		
MORGAN & FINNEGAN, L.L.P. 3 WORLD FINANCIAL CENTER NEW YORK, NY 10281-2101			EXAMINER CANGIALOSI, SALVATORE A	
			ART UNIT	PAPER NUMBER
			3621	

DATE MAILED: 10/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/868,435

Applicant(s)

DOLL-STEINBERG, DANIEL

Examiner

Salvatore Cangialosi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 22 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 26-31 and 50-75 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 26-31 and 50-75 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

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1. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

2. Claims 26-31 and 50-75 are rejected under 35 U.S.C. § 103 as being unpatentable over Slik et al (5809145) in view of either Grundy (5291598) or Richardson (5490216).

Regarding claim 26, Slik et al (See Figs. 3-6, 16, Col. 18, lines 30-55) disclose a means for distributing digital data with a remote licensing center issuing a release code to a local media store substantially as claimed. The differences between the above and the claimed invention is the use of explicit customer selected information. It is noted that the user selection of digital data and subsequent data exchange prior to purchase is functionally equivalent to the claim limitations. Each of Grundy (See Figs. 2b-4, 8 and 9) or Richardson (See Fig. 2-10) shows the manufacture of software based on user selection.

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It would have been obvious to the person having ordinary skill in this art to provide a similar arrangement for Slik et al because user selection and naming are conventional functional equivalents of the claim limitations. Regarding the print limitations of claim 27, Richardson (See Fig. 2-10) shows the manufacture of software based on user selection, which can obviously include a printed display shown in the Figures that are conventional functional equivalents of the claim limitations. Regarding protocol limitations of claim 28, Richardson (See Fig. 2-10) shows the manufacture of software based on user selection, which can obviously include a printed display shown in the Figures that is conventional functional equivalent of the claim limitations. Regarding personalization limitations of claim 29, Grundy (See Figs. 2b-4, 8 and 9) or Richardson (See Fig. 2-10) shows the manufacture of software based on user selection and thus personalized that is conventional functional equivalent of the claim limitations. Regarding the cd limitations of claim 30, Grundy (See Figs. 2b-4, 8 and 9) or Richardson (See Fig. 2-10) shows the manufacture of software based on user selection on cd media that are conventional functional equivalents of the claim limitations. Regarding print limitations of claim 31 Richardson (See Fig. 2-10) shows the manufacture of software based on user selection, which can obviously include a printed display shown in the Figures (which can employ any of the ubiquitous cd labeling applets) that is conventional functional equivalent of the claim

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limitations. Regarding claim 50, Slik et al (See Figs. 3-6, 16, Col. 18, lines 30-55) disclose a method for distributing digital data with a remote licensing center issuing a release code to a local media store substantially as claimed. The differences between the above and the claimed invention is the use of explicit customer selected information. It is noted that the user selection of digital data and subsequent data exchange prior to purchase is functionally equivalent to the claim limitations. Each of Grundy (See Figs. 2b-4, 8 and 9) or Richardson (See Fig. 2-10) shows the manufacture of software based on user selection.

It would have been obvious to the person having ordinary skill in this art to provide a similar arrangement for Slik et al because user selection and naming are conventional functional equivalents of the claim limitations. Regarding the user limitations of claim 51, Grundy (See Figs. 2b-4, 8 and 9) or Richardson (See Fig. 2-10) shows the manufacture of software based on user selection on cd media that are conventional functional equivalents of the claim limitations. Regarding the print limitations of claim 52, Richardson (See Fig. 2-10) shows the manufacture of software based on user selection, which can obviously include a printed display shown in the Figures that are conventional functional equivalents of the claim limitations. Regarding protocol limitations of claim 53, Richardson (See Fig. 2-10) shows the manufacture of software based on user selection, which can obviously include a printed display shown in the

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Figures that is conventional functional equivalent of the claim limitations. Regarding the storage limitations of claims 54-55, Grundy (See Figs. 2b-4, 8 and 9) or Richardson (See Fig. 2-10) shows the manufacture of software based on user selection on cd media that are conventional functional equivalents of the claim limitations. Regarding print limitations of claims 56-57, Richardson (See Fig. 2-10) shows the manufacture of software based on user selection, which can obviously include a printed display shown in the Figures (which can employ any of the ubiquitous cd labeling applets) that is conventional functional equivalent of the claim limitations. Regarding authenticity limitations of claims 58-59, Grundy (See Figs. 2b-4, 8 and 9) or Richardson (See Fig. 2-10) shows the manufacture of software based on user selection and thus personalized that is conventional functional equivalent of the claim limitations. Regarding print limitations of claims 60-62, Richardson (See Fig. 2-10) shows the manufacture of software based on user selection, which can obviously include a printed display shown in the Figures (which can employ any of the ubiquitous cd labeling applets) that is conventional functional equivalent of the claim limitations. Regarding the sale limitations of claims 63-68, Slik et al (See Figs. 3-6, 16, Col. 18, lines 30-55) disclose a method for distributing digital data with a remote licensing center issuing a release code to a local media store that is conventional functional equivalent of the claim limitations.

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Regarding sale limitations of claims 69-75, Grundy (See Figs. 2b-4, 8 and 9) or Richardson (See Fig. 2-10) shows the manufacture of software based on user selection and thus personalized that is conventional functional equivalent of the claim limitations because of the standard sale types enumerated.

**Examiner's Note:** Although Examiner has cited particular columns, line numbers and figures in the references as applied to the claims above for the convenience of the applicant(s), the specified citations are merely representative of the teaching of the prior art that are applied to specific limitations within the individual claim and other passages and figures may apply as well. It is respectfully requested that the applicant(s), in preparing the response, fully consider the items of evidence in their entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

Any inquiry concerning this communication should be directed to Salvatore Cangialosi at telephone number (703) 305-1837. The examiner can normally be reached 6:30 Am to 5:00 PM, Tuesday through Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell, can be reached at (703) 305-9768.

**Any response to this action should be mailed to:**

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 3600 Customer Service Office whose telephone number is (703) 306-5771.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
SALVATORE CANGIALOSI  
PRIMARY EXAMINER  
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